

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Peter SHINTANI  
Serial No. : 09/242,485  
For : INFORMATION RECEIVING DEVICE, AND ITS METHOD,  
AND INFORMATION TRANSMISSION DEVICE AND ITS  
METHOD  
Filed : November 15, 1999  
Examiner : Hunter B. Lonsberry  
Art Unit : 2623  
Confirmation No. : 1116

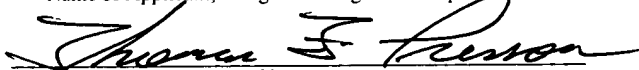
745 Fifth Avenue  
New York, NY 10151  
Tel: (212) 588-0800

**FIRST CLASS MAIL CERTIFICATE**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Briefs Patents, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 15, 2006.

Thomas F. Presson, Reg. No. 41,442

\_\_\_\_\_  
Name of Applicant, Assignee or Registered Representative

  
\_\_\_\_\_  
Signature

\_\_\_\_\_  
August 15, 2006

\_\_\_\_\_  
Date of Signature

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop Appeal Brief-Patents  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1451

Sir:

Applicant requests review of the Final Office Action dated June 13, 2006 in the above-captioned application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal and required fee. Please consider the reasons stated herein.

### **REASONS FOR REQUEST**

Claims 12, 14, 15, and 17, which are pending, were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Blahut (U.S. Patent 5,532,735) in view of Iwafune et al. (U.S. Patent 5,880,720), Smolen (U.S. Patent 5,915,243), Neel (U.S. Patent 5,838,314), Abecassis (U.S. Patent 6,553,178), and Goldhaber et al. (U.S. Patent 5,855,008). The present invention is directed to a method for ensuring that viewers actually view commercial programs in their entirety. In exchange for viewing the commercial programs, the viewer receives points which can be used to pay for pay programs.

Applicant respectfully submits that the applied combination of Blahut, Iwafune, Smolen, Neel, Abecassis, and Goldhaber is improper because it lacks motivation and relies on impermissible hindsight reconstruction of the claimed invention using a mosaic of features.

#### **Applied combination lacks motivation and relies on impermissible hindsight**

Applicant respectfully submits that MPEP §2143.01(III) states that

**“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”** *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)”  
(Emphasis added)

Applicant respectfully submits that the Office Action has failed to provide a convincing suggestion or motivation of the desirability of combining the teachings of Blahut, Iwafune, Smolen, Neel, Abecassis, and Goldhaber. The Examiner has relied on various ad-hoc motivations in an attempt to create a piecemeal combination of various random elements from the prior art. However, Applicant respectfully submits that no motivation is found anywhere in the art of record to suggest the desirability of the applied combination. Since there is no motivation in the references themselves or within the knowledge of one of ordinary skill, the

Examiner has relied on impermissible hindsight reconstructive reasoning to create a mosaic of features from the prior art in a futile attempt to create a vague resemblance of Applicant's claimed invention.

Specifically, Blahut describes a technique for an interactive television ("ITV") system wherein viewers are allowed to select a desired level of advertisements with which they are provided. The technique comprises transmitting to an interactive services subscriber location a program and a set of advertisements (collectively referred to as a "show"). The set of advertisements is selected based upon an input from a user associated with the interactive services subscriber location.

Iwafune relates to a television system in which two-way television sets communicate with a server via a communication network. Each interactive television includes a program control unit for controlling interactive data exchange between a viewer, a response receiving unit for identifying a response from the viewer to the program from input signals to the television, and a communication control unit for controlling communications with other nodes.

Smolen describes a method and apparatus for offering promotions to a consumer on the basis of a dynamic information profile for that consumer. The dynamic information profile is formed by creating an initial information profile for the consumer, selecting questions for the consumer based on the information profile, presenting the questions to the consumer, collecting the responses to the questions, and updating the information profile using the responses to the questions.

Neel describes an interactive video services system for enabling store and forward distribution of digitized video programming. Encoded and compressed digital video signals are transmitted via satellite link from a centrally located uplink site to a plurality of hospitality

establishments, where the digitized video programming is stored in the memory of a video server computer or is transmitted "real-time" to the hospitality establishment's customers.

Abecassis relates to a random access pointcast video delivery system provides the capability for a viewer to select a video advertisement. The video advertisement is automatically customized responsive to the application of the viewer's video content preferences to a video segment map defining a plurality of video segments. The viewer is compensated for the verified apparent viewing of the selected advertisement independently of the purchase of the advertised product or service. Where the advertisement is associated with a credit, the viewing of the advertisement subsidizes the viewer's receipt of other video and communication services. Where a viewing of a video results in a purchase, a deposit in the purchase is automatically escrowed until after the buyer has received satisfactory delivery of the purchase

Goldhaber describes distributing advertising and other information over a computer network. Compensation may be used directly or indirectly to compensate the owners of content or may be used for other purposes.

Applicant submits that there is no motivation to combine a technique for an interactive television (Blahut) with a television system in which two-way television sets communicate with a server via a communication network (Iwafune) with offering promotions to a consumer on the basis of a dynamic information profile for that consumer (Smolen) with an interactive video services system for enabling store and forward distribution of digitized video programming (Neel) with a random access pointcast video delivery system that provides the capability for a viewer to select a video advertisement (Abecassis) with distributing advertising and other information over a computer network (Goldhaber).

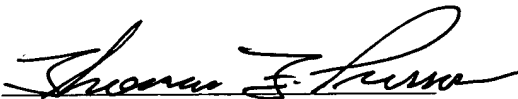
Accordingly, for at least these reason, the combination of Blahut, Iwafune, Smolen, Neel, Abecassis, and Goldhaber lacks motivation and is, therefore, improper. Since the Office Action has not made a *prima facie* case of obviousness, the rejection should be withdrawn.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing remarks, it is believed that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicant

By   
Thomas F. Presson  
Reg. No. 41,442  
(212) 588-0800